

**REMARKS**

Entry of the foregoing and reexamination and still further reconsideration of the subject application, as proposed to be amended, pursuant to and consistent with 37 C.F.R. § 1.116, are respectfully requested in light of the remarks which follow.

The acknowledgments of the claim for foreign priority, the certified copy of the priority document and the claim for domestic priority are noted with appreciation. Applicants also acknowledge, with thanks, the Examiner's return of an initialed copy of applicants' Form PTO-1449.

Upon entry of the foregoing amendment, Claims 27, 32, 37, 52, 62-64, 69, 81, 82, 85, 88-114, 117, 118, 121, 122 and 125 will be in this application. The foregoing amendment seeks to cancel Claims 30, 31, 35, 36, 40, 41, 55, 56, 66-68, 70-80, 83, 84, 86, 87, 115, 116, 119, 120, 123 and 124 and to amend Claims 27, 52, 62, 64, 82, 85, 88, 93, 96 and 108. As will be apparent from the discussion to follow, this amendment does not introduce new matter and does not raise new issues; moreover, it is believed that this amendment places all of the claims in condition for allowance. At the very least, this amendment places the claims in better condition for appeal. Therefore, entry is respectfully requested.

For the record, it is pointed out that the Summary page of the Official Action of July 1, 2003 indicates that the Action is Final and also that it is non-final. In light of page 9 of the Action, it is assumed that it is Final. It is also pointed out that the listing of claims indicates that Claim 42 was pending, but it was canceled in the Reply and Amendment filed

December 31, 2001. Further, the Action does not list Claim 40, which was not canceled but rather amended in the Reply and Amendment filed April 15, 2003, and was still pending. The present amendment, however, seeks to cancel Claim 40.

With respect to the support for the amendments proposed hereinabove, the following remarks are submitted:

Claim 27 is proposed to be amended to include the language of Claim 30 therein; and to recite the amount of cinnamic acid as ranging from  $10^{-6}$  percent to 0.01 percent, a limitation previously recited in Claim 68. Consistent with this amendment, Claims 30, 31, 35, 36, 40, 41, 55, 56, 66-68, 70-77, 115-116, 119-120 and 123-124 are proposed to be canceled.

Claim 52 is proposed to be amended to correct the Markush language.

Claim 62 is proposed to be amended by reciting therein the  $10^{-6}$  percent to 0.01 percent amount of cinnamic acid, previously recited in Claim 68; consistent therewith, Claims 66-68 and 78-80 are proposed to be canceled.

Claim 64 is proposed to be amended to correct the Markush language.

Claims 82 and 85 have been proposed to be amended to recite the same  $10^{-6}$  percent to 0.01 percent range of cinnamic acid, consistent with the amendments to Claims 27 and 62 discussed above; in accord with this amendment, Claims 83, 84, 86 and 87 are proposed to be canceled.

Claims 88-92 have been objected to as dependent on a rejected claim. Claim 88 has been rewritten as an independent claim including all of the limitations of Claim 62 as

previously presented, from which it depended. Claims 89-92 properly depend from Claim 88. Thus, in all of these claims, (b) is  $\beta$ -naphthoxyacetic acid.

Claims 93-95 have also been objected to as dependent upon a rejected claim. Claim 93 has been rewritten as an independent claim including all of the limitations of Claim 85 as previously presented, from which it depended. Claims 94 and 95 properly depend from Claim 93. In all of these claims, (b) is  $\beta$ -naphthoxyacetic acid.

Claim 96 is proposed to be amended to correct a typographical error.

Claims 108-113 have been objected to as dependent upon a rejected claim. Claim 108 has been rewritten as an independent claim, including all of the limitations of Claim 102, from which it previously depended. Claims 109-113 properly depend from Claim 108. In all of these claims, (b) is  $\beta$ -naphthoxyacetic acid.

It is clear from the foregoing that no new matter will be introduced by the proposed amendments. Furthermore, no new issues will be raised, as all of the proposed language was previously located in claims previously on file.

We turn now to the objections and rejections raised in the Official Action.

Claims 30, 31, 35, 62, 63 and 70-77 have been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 30, 31, 35 and 70-77 are proposed to be canceled, obviating the objection with respect thereto. Claim 62 is an independent claim, while Claim 63 depends therefrom and limits (b) to a particular group, therefore is narrower in scope than Claim 62 and is properly dependent thereon. Moreover, Claim 62 differs in scope from

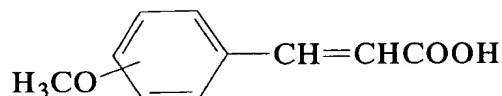
Claim 27, because Claim 62 requires as (a) cinnamic acid or a mixture of cinnamic acid and at least one derivative thereof, while Claim 27 requires as (a) cinnamic acid or a mixture of cinnamic acid and at least one derivative thereof selected from the group consisting of mono- and polyhydroxy-cinnamic acids, and alcohols and aldehydes of cinnamic acid. Thus, Claim 27 is narrower in scope than Claim 62. A mixture of cinnamic acid and ethyl cinnamate (which is an ester of cinnamic acid), for example, falls within the scope of (a) in Claim 62 but not within the scope of (a) in Claim 27, which does not include esters as one of the enumerated cinnamic acid derivatives. Thus, this objection cannot be maintained.

Claims 27, 30-31, 60-61, 66-67, 70-71, 74-77 and 82-84 have been rejected under 35 U.S.C. § 102(b) as clearly anticipated by Georgalas EP 0275719. Claims 60-61 were previously canceled and thus are not in the application. Claims 30-31, 66-67, 70-71, 74-77, 83 and 84 are proposed to be canceled, obviating the rejection with respect thereto. As to Claims 27 and 82, both of these claims now require that the amount of cinnamic acid be from  $10^{-6}$  percent to 0.01 percent relative to the total weight of the composition. EP '719 teaches that a suitable UV-B absorber for use in its composition includes, among others, methoxycinnamic acid, cinnamic acid and ferrulic acid and further teaches that the desired UV-B absorber "will be present in the final product in an amount of from about 0.25 to about 20 percent by weight, preferably from about 1 to 8 percent by weight of the total formulation." See page 3, lines 11-15 of the cited document. EP '719 neither discloses nor suggests that the extremely small percentages recited in applicants' proposed amended

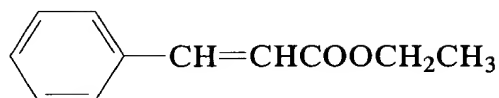
Claims 27 and 82 would be useful as its UV-B absorber. The proposed amendment clearly overcomes the § 102 rejection of these claims. Entry of the amendment and withdrawal of the rejection are believed to be in order and are earnestly solicited.

Claims 32, 35-36, 62, 68-69, 72-73, 78-81, 85-87, 96-101, 114-116 and 118-120 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Georgalas EP 0275719. Claims 35, 36, 68, 72, 73, 78-80, 86, 87, 115, 116, 119 and 120 are proposed to be canceled by the present amendment, rendering the rejection moot with respect thereto. With respect to Claims 32, 62, 69, 81, 96-101, 114 and 118, it is submitted that the rejection is untenable for the reasons set forth below.

It is agreed that EP '719 teaches compositions comprising a sunscreen and a cosmetically acceptable carrier. One of the sunscreens disclosed is cinnamic acid; methoxycinnamic acid and ferrulic acid are also disclosed. However, as pointed out above, EP '719 absolutely requires from about 0.25 to about 20 percent by weight of its UV-B absorber. Example 1 of EP '719 does teach use of a mixture of UV-B absorbers in a single composition, but the mixture of Example 1 does not comprise cinnamic acid and moreover contains 11.5% UV-B absorbers. Further, the Examiner has erred in stating that EP '719 teaches a homolog of ethyl cinnamate. Methoxycinnamic acid, not methyl cinnamate, is disclosed by EP '719. Methoxycinnamic acid has the formula:



Ethyl cinnamate has the formula:



Clearly, these compounds are not homologs. The structure of the reference's methoxycinnamic acid does not suggest the structure of applicants' ethyl cinnamate.

Claims 32 as proposed to be amended distinguishes from EP '719 at least in that its composition comprises from 10<sup>-6</sup> percent to 0.01 percent cinnamic acid, which is orders of magnitude smaller than the smallest amount required by EP '719. Such a tiny amount, far less than that required by the reference as a sunscreen, is in no way taught or suggested by the reference and is in no way obvious to one of ordinary skill. Claims 62, 69, 81, 114 and 118 as proposed to be amended distinguish from the reference for at least the same reason as Claim 32.

Claims 96-101 are drawn to compositions in which (a) is a mixture of cinnamic acid and ethyl cinnamate. As explained above, there is no homolog of ethyl cinnamate disclosed in EP '719. Indeed, there is no suggestion of a mixture of cinnamic acid and ethyl cinnamate in the reference. In addition, Claims 99-101 further distinguish from EP '719 in specifying amounts of cinnamic acid far below those required by the reference as a sunscreen. All of Claims 96-101 are clearly free of the cited art.

From the foregoing, it is apparent that all of the claims as proposed to be amended hereinabove are free of the §103(a) rejection based on EP '719 alone.

Claims 37, 40, 41, 63, 102-107, 117 and 121-124 have been rejected under 35 U.S.C. §103(a) as unpatentable over EP '719 in view of Lee et al U.S. Patent No. 5,545,399. EP '719 has been relied upon by the Examiner for its teachings discussed above and the '399 patent for teaching the inclusion of vitamin C (ascorbic acid) as a skin whitening agent. Claims 40, 41, 123 and 124 have been proposed to be canceled, obviating the rejection with respect to those claims. The remaining rejected claims, i.e. Claims 37, 63, 102-107 and 117, distinguish over the combination of references at least because the primary reference, EP '719, is deficient. Claim 37 requires from  $10^{-6}$  percent to 0.01 percent of cinnamic acid, far below the lowest amount suggested by EP '719 for use as a sunscreen, thus one of ordinary skill combining EP '719 with the '399 patent's vitamin C would never arrive at applicants' Claim 37 with its extremely low percentage cinnamic acid content. The same is true of Claim 63, which likewise specifies an extremely low percentage of cinnamic acid. Claim 102 and its dependent claims, Claims 103-107, require a mixture of cinnamic acid and ethyl cinnamate; as pointed out above, EP '719 discloses methoxycinnamic acid, not methyl cinnamate, not a homolog but a structurally distinct compound. There is nothing in EP '719 which would lead one of ordinary skill to make the specific combination of cinnamic acid plus ethyl cinnamate, then combine it with vitamin C or other product encompassed by (b) of Claim 102. Claims 105-107 further distinguish by limiting the amount of cinnamic acid to very small amounts far below what EP '719 discloses is required for its sunscreen compositions. Claim 117 is free of this rejection at least by virtue of its dependency on Claim 62, which limits the

amount of cinnamic acid to far below the amount required by EP '719. There is no suggestion that such a small amount would be useful in EP '719; to the contrary, that document requires an absolute minimum of 0.25%, more than 20 times the maximum concentration allowed by Claim 117. There is absolutely no motivation in the cited art to combine such a very small amount of cinnamic acid with Lee et al's vitamin C.

From the foregoing, it is apparent that all of the claims as proposed to be amended hereinabove are free of the 35 U.S.C. §103(a) rejection based on EP '719 in view of the '399 patent.

Claims 52, 55, 56 and 65 have been rejected under 35 U.S.C. §103(a) as unpatentable over EP '719 in view of McAuslan WO 88/01166. EP '719 has been relied upon for reasons stated previously, '166 for teaching inclusion of anti-inflammatory plant hormones in topical compositions. Claims 55, 56 and 65 have been proposed to be canceled, so that the rejection is rendered moot in their regard. As to Claim 52, this claim depends ultimately from Claim 27, which as proposed to be amended requires that the amount of cinnamic acid range from  $10^{-6}$  percent to 0.01 percent, and therefore for reasons stated previously cannot be deemed obvious to one of ordinary skill from the many times higher amounts required by EP '719 as a sunscreen. The inclusion of the anti-inflammatory plant hormones of '166 in EP '719's composition would result in a composition containing much higher amounts of cinnamic acid (0.25% to 20%). There is nothing in the art suggesting the exceedingly small amount of cinnamic acid encompassed by Claim 52. Accordingly, this rejection cannot be maintained against the instant claims.



Claim 125 has been rejected under 35 U.S.C. §103 as unpatentable over EP '719 in combination with Lee et al '399 in further combination with McAuslan '166. This rejection is untenable at least because of the failure of the primary reference, EP '719. Claim 125 depends from Claim 62 and therefore as proposed to be amended limits the amount of cinnamic acid to  $10^{-6}\%$  to 0.01%. As noted throughout this response, EP '719 requires as a minimum amount of sunscreen more than twenty times the maximum amount encompassed by Claim 125. Thus one of ordinary skill would need to first drastically reduce the amount of cinnamic acid before adding the '399 and '166 ingredients, and there is no motivation to do so in the cited art.

Claims 88-95 and 108-113 have been objected to as being dependent upon a rejected base claim. As noted hereinabove, Claim 88 has been proposed to be rewritten as an independent claim to include the limitations of previous Claim 62, while Claims 89-92 depend from Claim 88; Claim 93 has been proposed to be rewritten to as an independent claim to include the limitations of previous Claim 85, while Claims 94 and 95 depend from Claim 93; and Claim 108 has been proposed to be rewritten as an independent claim to include all of the limitations of previous Claim 102, while Claims 109-113 depend from Claim 108. Therefore, all of Claims 88-95 and 108-113 are believed to be free of the record objection.

As to the double patenting/duplicate claiming rejections, the following comments are offered:

With respect to Claims 27, 30 and 31, it is pointed out that only Claim 27 will remain in the application following entry of this amendment, thus there can be no question of double patenting/duplicate claiming.

With respect to Claims 32, 35 and 62, it is pointed out that Claim 35 (as well as Claim 36) is to be canceled by this amendment. Claims 32 and 62 differ in scope because the definition of (a) is narrower in Claim 32 by virtue of its dependency on Claim 27 than is the definition of (a) in Claim 62. This was explained earlier in this response. The cinnamic acid derivatives of Claims 27 and 32 are more limited. Thus, there would be no duplicate claiming if both Claims 32 and 62 were allowed.

Claims 37 and 63 differ in scope for the same reason that Claims 32 and 62 differ in scope, that is, because of the cinnamic acid derivatives being more narrowly defined in Claim 37. There would thus be no double patenting/duplicate claiming if both Claim 37 and 63 were allowed.

As to Claims 66, 70 and 74, all of these claims will be canceled upon entry of this amendment, rendering moot any possible double patenting/duplicate claiming issues with respect thereto.

With respect to Claims 67, 71 and 75, all of these claims will be canceled upon entry of this amendment, obviating the possible double patenting or duplicate claiming issue.

In regard to Claims 68, 72 and 76, these claims will also be canceled upon entry of the present amendment, obviating the possible double patenting/duplicate claiming issue.

With regard to Claims 69, 73 and 77, as Claims 73 and 77 are to be canceled by the present amendment, the double patenting issue is obviated and the allowance of Claim 69 would not result in duplicate claiming.

Claim 27, 30-32, 35-37, 41-42, 52, 55, 56, 62-64 and 66-125 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 56-58 of copending Application No. 09/887,073. Claims 56-58 of copending Appln. No. 09/887,073 are now Claims 1-3 of Breton et al U.S. Patent No. 6,660,283 B2, issued December 9, 2003. Some of the claims of the present application still overlap with those granted in the '283 patent; therefore, to overcome this provisional rejection, an appropriate terminal disclaimer and the requisite fee are filed concurrently with this response.

In view of the foregoing, it is respectfully requested that this amendment be entered and that all of the claims as amended be allowed.

If there are any remaining issues which could be resolved by means of a telephone conference, the Examiner is urged to telephone the undersigned at the number given below.

Respectfully submitted,

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